

Appl. No 10/688,571

Amendment dated January 3, 2006

Reply to office action of December 21, 2005

Remarks/Arguments

In the Office Action it is noted in item 3 that Claims 1-31 are rejected under 35 U.S.C. 112 second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular the Office Action noted the phrase "the display material" renders the claims(s) indefinite because the phrase lacks antecedent basis.

Applicant amends Claims 1, 2, 11, 12, and 14 to consistently refer to a photograph or card display material as the item displayed in applicant's invention.

In the office action it is also noted in item 4 that Claim 1 and Claim 12 are unclear as to whether the claim includes the photograph or card in combination with the display device. Applicant has amended Claims 1, 2, and 11 to distinctly point out the photograph or card display material when engaged with applicant's invention provides a free standing display using the edge or edges of the photograph or card display material and the edge of applicant's invention, as shown in applicant's figures 2, 3, and 4 and as described in applicant's specification, page 6, paragraph 1 under "Operation-Preferred Embodiments."

In the Office Action it is noted in item 5 that Claim 31 is indefinite because both means phrases appear to describe the same structure. Applicant cancels Claim 31.

Applicant believes the claims have been amended such that Claims 1-30 particularly point out and distinctly claim the subject matter which applicant regards as the invention. The rejections under 35 U.S.C. 112 second paragraph are therefore respectfully requested to be removed.

In item 7 the Office Action noted that Claim 31 is rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 2,532,132 (Vogel). Applicant has canceled Claim 31, so this rejection is moot.

In the Office Action, items 9-12, Claims 1, 4, 5, 7, 10, 11, 12, 14, 15, 17, 20, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Noel, U.S. Patent 2,873,545 in view of Vogel, U.S. Patent 2,532,132. Applicant respectfully traverses this rejection.

Applicant respectfully notes a patent rejection under 35 U.S.C. 103(a) bears the initial burden of factually supporting any prima facie conclusion of obviousness. This initial burden includes providing some suggestion of the desirability of doing what the inventor has done in the prior art reference. To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

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The Noel (2,873,545) reference teaches tracing two slightly disposed duplicate pictures onto two transparent acetate sheets in two colors and then arranging the acetate sheets in an arched position in a frame and viewing the sheets with corresponding colored lens so as to view a three-dimensional image. The Vogel (2,532,132) patent is a card holder that uses a series of opposing slits to hold cards or photographs of varying size.

The cited references, Noel and Vogel are in different arts, one producing a three dimensional picture, the other displaying a flat card. There is no teaching, suggestion, or motivation in Noel to hold more than one picture and there is no teaching, suggestion, or motivation in Vogel to display a card or photograph in a curved position. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990) Also, just because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a prima facie case of obviousness without some objective reason to combine the teachings of the references. Ex parte Levengood, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). See also In re Kotzab, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1318 (Fed. Cir. 2000)

The cited references do not teach all of applicant's limitations in applicant's amended Claim 1, Claim 2, and Claim 11. The photograph or card display material when engaged with applicant's invention provides a free standing display using the edge or edges of the photograph or card display material and the edge of applicant's invention, as provided for in the amended Claims 1, 2, and 11, as described previous. Neither reference, Noel (2,873,545) or Vogel (2,532,132) teaches a self-standing display. These claims are therefore allowable and the rejection of Claims 1 and 11 is respectfully requested to be removed.

In regard to the Office Action items 13 and 14, Claims 4, 5, 7, and 10 are dependent claims on Claim 1, Claims 12, 14, 15, 17, 20 and 21 are dependent claims on claim 11. Since these claims depend from a now allowable claim, these are allowable claims.

Claims 1, 4, 5, 7, 10, 11, 12, 14, 15, 17, 20, and 21 have therefore been shown to be allowable claims and the rejection is respectfully requested to be removed.

In the Office Action, item 15, Claims 2, 3, 6, 8, 9, 13, 16, 18, 19, 22-30 are objected to as being dependent upon a rejected base claim. Since the base claims have been amended to be allowable the objection to these claims is respectfully requested to be removed.

Claims 13 and 18 have been amended to correct matters of form.

The applicant respectfully submits that all current claim amendments have been made in response to the rejections of the Office Action of December 21, 2005, and therefore do not raise new issues. If, however, there is disagreement on this point, applicant submits making the Office Action of December 21, 2005 a final action is improper as Claims 1-30 were previously indicated in the Office Action of September 21, 2005 as allowable claims if rewritten to

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overcome the rejections under 35 U.S.C. 112, 2nd paragraph. The MPEP in section 706.7 states that "present practice does not sanction hasty and ill-considered final rejections. The applicant who is seeking to define his or her invention in claims that will give him or her the patent protection to which he or she is justly entitled should receive the cooperation of the examiner to that end, and not be prematurely cut off in the prosecution of his or her application.... The examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed...." The applicant respectfully submits making the Office Action of December 21, 2005 final is premature and requests the finality of the Office Action be withdrawn.

Applicant respectfully submits that the claims, as amended, satisfy all the examiners objections. The applicant's invention as presently claimed is patentably distinct from the prior art, as has been shown. The applicant submits the application is in condition for allowance, and that action is earnestly solicited.

Respectfully submitted,



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